



HL
PATENT
Attorney Docket No. 05725.0505
Application No.: 09/838,197

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
David W. CANNELL et al.) Group Art Unit: 1751
Application No.: 09/838,197) Examiner: E. Elhilo
Filed: April 20, 2001)
For: COMPOSITION AND METHODS)
FOR LANTHIONIZING KERATIN)
FIBERS USING AT LEAST ONE)
ORGANIC NUCLEOPHILE AND)
AT LEAST ONE HYDROXIDE)
ION GENERATOR)

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Assistant Commissioner for Patents
Washington, DC 20231

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In the Office Action mailed September 10, 2002, the Examiner has required
restriction between the following groups of claims:

Group I Claims 1-74 and 157-158, drawn to a composition comprising at least one organic nucleophile and at least one hydroxide ion generator, classified in class 424, subclass 70.2;

Group II Claims 75-150 and 159-160, drawn to methods for lanthionizing keratinous fibers with compositions comprising at least one organic nucleophile and at least one hydroxide ion generator, classified in class 132, subclass 202; and

Group III Claims 151-156, drawn to a kit comprising a first component comprising at least one organic nucleophile and a second component comprising at least one hydroxide ion generator, classified in class 132, subclass 212.

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The restriction requirement, as set forth above and on page 2 of the Office Action, is respectfully traversed. However, to be fully responsive to the restriction requirement, Applicants elect, with traverse, the subject matter of Group I, claims 1-74 and 157-158.

The Examiner states that the inventions are distinct because they are related as a "product and process of use" (Inventions I and II), or as a "combination and subcombination" (Inventions I and III), or as a "process and apparatus for its practice" (Inventions II and III). See pages 2-3 of the present Office Action. Applicants refer the Examiner to M.P.E.P. § 803, which sets forth the criteria and guidelines for Examiners to follow in making proper requirements for restriction. The M.P.E.P. instructs Examiners as follows:

If the search and examination of an entire application can be made without serious burden, the Office must examine it on the merits, even though it includes claims to distinct or independent inventions.

M.P.E.P. § 803 (emphasis added).

Here, the Examiner has not shown that examining the above groups together would constitute a serious burden. According to the present Office Action, Inventions II and III are both classified in the identical class 132. Claim 36 of Invention I and claim 75 of Invention II both require a pretreatment composition comprising at least one organic nucleophile present in an amount effective to increase the tensile strength of said keratin fibers. Claim 1 of Invention I and claim 151 of invention III both require at least one organic nucleophile and at least one hydroxide ion generator for lanthionizing keratin fibers. Accordingly, a search for these groups of claims will substantially, if not

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completely, overlap. Thus, for at least this reason, Applicants respectfully submit that the restriction requirement is in error and request that the requirement be withdrawn.

If the Examiner believes a telephone conference would be useful in resolving any outstanding issues, he is invited to call the undersigned at (202) 408-4173.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P

Chalia V. Wainemat, Reg. No. 39,064
By: *for Anthony C. Tridico*
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Date: November 8, 2002

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